

REMARKS

Responsive to the final Office Action mailed August 2, 2005, enclosed herewith for filing is a Request for Continued Examination (RCE) and an Information Disclosure Statement.

In the final Office Action, claims 1, 19 and 37 were rejected under 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of these rejections are respectfully requested.

In the §112(1) rejection, the Examiner rejected the claims and the arguments relative thereto based on the basis of the negative limitation "retrieving at least one but not all of the plurality of blocks defined in the script of the requested document from a memory". The Office further stated that this limitation had not positive basis in the originally filed specification. During the telephone conference of November 2, 2005, the Examiner stated that, because the aforementioned negative limitation was considered to be new matter, the grounds for rejection advanced in the Office Action of December 1, 2004 were repeated verbatim in the Office Action of August 2, 2005, without consideration of the "at least one but not all" limitations added to the claims. In support of the §112(1) rejection, the Office points to the MPEP, at section 2173.05(i). This passage of the MPEP is sufficiently brief to be reproduced below in its entirety:

2173.05(i) Negative Limitations

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized

developing agent" was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Thus, the Patent Office's own guide states that there is "nothing inherently ambiguous or uncertain about a negative limitation". And further, "So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph". The MPEP does caution, however, that "Any negative limitation or exclusionary proviso must have basis in the original disclosure."

However, "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." Then the MPEP also points us to "*In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977)" in which the CCPA stated that ("[the] specification, having described the whole, necessarily described the part remaining."), and that "lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support." Thus, the MPEP and the courts are explicit and in full agreement that if elements are positively recited in the specification, they may be excluded in the claims. Therefore, the applicant may choose to exclude certain elements of his or her invention in the claims, provided that those elements are positively recited in the claims. The CCPA emphasized that point when it stated that as long as the specification describes the whole, it necessarily described any part remaining after a negative limitation is taken into

account. Therefore, the applicant is free to claim any part of the whole (of the invention) that was described in the specification. That is exactly the case here.

In this regard, the Examiner's attention is respectfully drawn to, e.g., Fig. 5 and the corresponding written portions of the specification. Therein, step S53 calls for a determination of whether at least one block of requested page is present in cache memory. This step satisfies, on its face, the "at least one but not all" limitation to the claims. Indeed, the "at least one but not all" may be considered a subset of the greater whole that is represented by and shown at steps S53 and S59. S59 calls for a determination of whether all blocks of requested page have been retrieved and/or generated. If the answer to S53 and S59 are both "Yes", then all blocks may have been retrieved from memory. It is respectfully submitted that this disclosure allows the applicant to claim less than the whole; that is, less than retrieving all of the blocks from memory, as currently claimed. That there is not a literal basis in the specification for the negative limitation does not, without more, meet the prima facie requirements for lack of descriptive support, as indicated above. As the specification (both the written and the drawing portions) amply disclose the range from "at least one block" (step S53) to "all blocks of requested page retrieved from memory" (step S59), the applicants are, according to the PTO's own guidelines, entitled to claim anywhere in between, including the presently claimed "at least one but not all", for the reasons set forth above.

Keeping the foregoing in mind, claims 1-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over McLaughlin et al. (U.S. Patent No. 5,988,847) and Nazem et al. (U.S. Patent No. 5,983,227) in view of Michel K. Bowman-Amuah (U.S. Patent No. 6,742,015). Claims 1-60 are currently pending. Reconsideration and withdrawal of these rejections are respectfully requested.

Each of the independent claims has been amended to recite that “at least one but not all of the plurality of blocks” are retrieved from a memory and “remaining ones of the plurality of blocks ... that are not stored in the memory” are dynamically generated. Thus, each of the independent claims requires that some of the blocks be retrieved from a memory and that all remaining blocks defined in the script be dynamically generated.

The applied combination, however, does not teach or suggest that some of the blocks be retrieved from a memory and that all remaining blocks defined in the script be dynamically generated, as claimed herein. Indeed, the primary reference to McLaughlin teaches an all or nothing approach to serving a client application with process data:

When a client application requires process data, a data request is sent to supervisory controller 120 and is received in cache manager 220. In one embodiment of the present invention, cache manager 220 first searches dynamic cache
10 220 for the requested process data. If the process data is found (a cache hit), cache manager 220 transfers the process data to the requesting client application and the transaction is ended. If the data is not found (a cache miss), cache manager 220 then requests the process data from the appropriate one of process nodes 204–206. When the supervisory
15 controller 120 receives the process data from the process node, cache manager 215 writes the process data into dynamic cache 215 and transfers the process data to the client application that originally requested it.

as shown in Column 8, lines 6-19. Either process data is present in the cache 220 or it is fetched from one of the process nodes 204-206. No provisions are made within McLaughlin for retrieving some of the blocks from the memory and dynamically generating remaining ones of the plurality of blocks. Alternatively, McLaughlin teaches that process data may be obtained in a peer-to-peer fashion, as detailed in Column 6, lines 22-25 or via a publish/subscribe model, as detailed in Column 3, lines 55-57.

Similarly, all of the supervisory data is dynamically generated, as positively stated in Column 5, lines 33-36:

optimize the facility as a whole. In a preferred embodiment, the supervisory data is dynamically generated and is based at least upon a given facility's efficiency, production or economic cost, and most preferably all three. 35

i.e., none of the supervisory data is retrieved from a cache memory. Therefore, McLaughlin does not teach or suggest retrieving some of the blocks from the memory and dynamically generating remaining ones of the plurality of blocks, as required by the claims.

The outstanding Office Action states that Nazem et al. teaches a document that includes a plurality of blocks. However, Nazem et al. does not remedy the fundamental shortcomings of the primary reference and does not teach – alone or in combination with McLaughlin - to retrieve some of the blocks from the memory and to dynamically generate remaining ones of the plurality of blocks, as claimed herein. Indeed, Nazem et al. teaches the use of templates to hold the static data and to obtain all live data from the shared memory 212:

in further detail. User front page 218 is built according to a user template and live data. The user template specifies, for example which quotes are shown in the portfolio module, which cities are displayed in the weather module, etc. Each of the modules 504 can be customized by a user and moved about front page 218. The modules 504 are also reusable, in that any customized module which appears on multiple pages can be edited from any one of those pages and the edits will be reflected on each of the pages. Other custom pages for the user can be viewed by selecting one of the page buttons 502 appearing below the header. Other pages and utilities can be selected using the buttons 508 which are part of the header. 65

In addition to all of the live data shown in FIG. 5 being stored in the shared memory, summaries from each of the

as stated in line 66-67 above. Nazem et al. teaches that the template data is stored (and necessarily retrieved from) the cached user templates database 214 and that all of the live data to fill these templates is stored in (and necessarily retrieved from) the shared memory 212. Therefore, even when considered collectively with the McLaughlin reference, Nazem et al. does not teach or suggest to retrieve some of the blocks from the memory and to dynamically generate remaining ones of the plurality of blocks, as required by each of the independent claims herein. It

is respectfully submitted that adding the Bowman-Amuah reference to the mix does not provide any additional guidance to the person of ordinary skill in this art. The cited passages simply do not teach anything relevant to blocks of a document including a reference to a data source and code that is configured to access and format data accessed from the data sources, as required by the claims. Indeed, Column 52, lines 55-61 deals with ID and password pairs:

55 resources, as opposed to securing an applications detailed functions.

The security component prevents unauthorized users from accessing corporate data/resources by providing the users with access codes—password & ID—that allows the user to
60 login to the system or execute any (or a particular) application.

while Column 47, lines 30-67 deals with wholly unrelated performance issues:

How important is performance?

In general, performance of data access and printing should be considered. Some typical benchmark tests include table scan, single-table report, joined table report, and mailing label generation times. (source is market research)

What is the budget?

Per developer costs as well as run time licensing fees, maintenance costs, support fees, and upgrade charges should be considered.

Do I have another component that satisfies this requirement?

Many databases and application development tools are shipped with built in or add-on report writing capability. However, stand-alone report writers: (1) are more powerful and flexible, especially when dealing with multiple data sources and a wide variety of formats; (2) can retrieve information from more data sources than the bundled report writers and can create reports from several data sources simultaneously; (3) excel in ease of use, both in designing and generating reports; (4) offer better tools and more predefined reports; and (5) have faster engines. (source is market research)

Does the product integrate with the existing or proposed architecture?

It is important to consider how well a product integrates with desktop tools (word processing, spreadsheet, graphics etc.) and application development programs. These items can be used to extend the capabilities of the reporting package.

What databases does the product support?

A product should support the most widely used PC file formats and Client/Server databases. It may be necessary to consider the type of support. For example, native database interfaces tend to have better performance than open standards such as ODBC. Another possible consideration is how well the product accesses multiple files or databases. (source is market research)

It is respectfully submitted that the applied combination, therefore, does not teach or suggest any method, system or media configured to:

retrieving **at least one but not all** of the plurality of blocks defined in the script of the requested document from a memory, the memory storing the at least one of the plurality of blocks defined in the script of the requested document; and dynamically generating **remaining ones of the plurality of blocks** defined in the script of the requested document that are not stored in the memory and storing a copy of each dynamically generated block in the memory. (Bold and underlining added for emphasis only)

as claimed in each of the independent claims. Reconsideration and withdrawal of the outstanding art rejections based upon the McLaughlin, Nazem et al. and Bowman-Amuah references are, therefore, respectfully requested.


As the rejections of the independent claims are deemed to have been overcome, it is not believed necessary to discuss the rejections of the dependent claims at this time, as they incorporate the patentable features of the independent claims from which they depend.

Applicants believe that this application is now in condition for allowance. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below and whatever is necessary to resolve such issues will be done at once.

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Respectfully submitted,

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